

REMARKS

CLAIM REJECTIONS- 35 U.S.C. § 103(a)

In the Office Action, claims 1-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrmann, US Patent No. 5,995,756, and further in view of Prithviraj et al., US Patent 5,987,513. Applicants respectfully traverse and request the Examiner to consider the following remarks.

Legal Principles

Certain well established principles must be observed in assessing whether or not an invention is patentable under 35 U.S.C. 103(a). First, the claims of a patent, which define the invention, are “to be construed in light of the specification and both are to be read with a view to ascertaining the invention.” United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966). The “differences between the prior art and the claims at issue are to be ascertained.” Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Moreover, it is elementary that the claimed invention must be considered as a whole in deciding obviousness. Litton Industrial Products, Inc. v. Solid State Systems Corp., 755 F. 2d 158, 164, 255 USPQ 34, 38 (Fed. Cir. 1985). The prior art as a whole must be considered, and those portions of the prior art arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc v. Barnes-Hind/Hydrocurve, Inc., 796 F. 2d 443, 448, 230 USPQ 416, 420 (Fed. Cir. 1986), In re Hedges, et al., 783 F. 2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). Moreover, “[t]he mere fact that the prior art could be ... modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” (Emphasis supplied.) In re Gordon, 733 F. 2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) which cites with approval Carl Schneck, A. G. v. Nortron, Corp., 713 F. 2d 782, 787, 218 USPQ 698, 792 (Fed. Cir. 1983) and In re Sernaker, 702 F. 2d 989, 995-96, 217 USPQ 1, 6-7 (Fed. Cir. 1983), both citing In re Imperato, 486 F. 2d 585, 587, 179 USPQ 730, 732 (CCPA 1973). In accord, In re Laskowski, 871 F. 2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

Establishing a *prima facie* case of obviousness requires that the prior art give reason or motivation to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), cert denied, 500 U.S. 904 (1991). (Emphasis supplied.) Second, there must be a reasonable expectation of success. Third, the references when combined must teach or suggest all the claim limitations. MPEP 2141. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (1991).

The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the modification. MPEP 2143 (emphasis supplied).

Finally, it is impermissible to first ascertain factually what the inventor did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the invention from such prior art. Panduit Corp. v. Dennison Manufacturing Co., 774 F. 2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985). (Emphasis supplied.)

Applying these principles to the invention as embodied in the present claims and to the Herrmann and Prithviraj references, the Applicants respectfully submit that a proper reading of the references fails to disclose or to even the invention embodied in the present claims.

The Herrmann Patent

Herrmann discloses a form-based development environment for partitioning an application such that it can be seamlessly integrated into intranets. More specifically, the Hermman patent discloses a process of downloading an ActiveDocument enabled Form object from an HTTP-server codebase to a client machine. The process begins when a user selects a downloadable ActiveDocument; this occurs in the same manner that the user typically selects an HTML page. The user may type a URL address into the browser or click on a hyperlink. The

browser then makes a request to the HTTP server for the specified file, using the HTTP GET command.

In response to receiving the request, the HTTP server returns the requested file in binary form, including a header that contains information about the file. Of particular interest in the header is the file's MIME type. When the browser receives the binary file from the server, it needs to determine how to display the file. The operating system maintains a registry of information that, among other things, indicates whether an ActiveDoc Server is to be used to display a particular MIME type. Upon receiving a file with a header, the browser looks up the MIME type in the system registry to determine which ActiveDoc object will handle the display of the object.

The Prithviraj Patent

The Prithviraj patent discloses a network management system which enables a user to manage a network using browsers available on remote computer systems. A designer provides a page specification document identifying information elements of interest and corresponding explanatory labels. The page specification document is then translated into a plurality of hypertext documents, which may include templates that for display of data dynamically retrieved from the network elements.

Applying the Herrmann and Prithviraj References to Claims 1-6 and 10

In the Office Action, the Examiner's Action indicated that Herrmann discloses a method of hosting internet content comprising: receiving an address of a definition from a computing device; locating said definition in a database using said address; and transmitting said definition to said computing device. The Examiner's Action further indicated that, although Herrmann did not disclose wherein said definition defines a frame and a location of content with which to fill in said frame, Prithviraj teaches templates (definitions) including dynamic fields, which store data dynamically retrieved from the network.

The Applicants respectfully traverse. Controlling authority mandates that the claimed invention must be considered as a whole in deciding obviousness. Further, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

As claimed in claims 1 and 10, the invention includes a limitation that "said definition defines a frame and a location of content with which to fill said frame," and a limitation of "locating said definition in a database using said address." When read as a whole, the invention of claim 1 requires the step of locating a definition, which defines a frame and a location of content with which to fill said frame, from the database. The Applicants respectfully submit this step is not taught or suggested by Herrmann or Prithviraj, individually or in combination. The term "database" does not even appear in the Herrmann and Prithviraj references.

Furthermore, even if Prithviraj teaches templates that define a frame and a location of content with which to fill said frame, there is no motivation to modify the teachings of the Herrmann patent with the teachings of Prithviraj. The Examiner's Action finds that the teachings are combinable merely by asserting, without citation either to Herrmann's patent or to any controlling case authority that:

Since Prithviraj teaches a network management system which enables a user to manage a network using browsers available on remote computer systems, which is similar to system for internet-based delivery of computer applications of Herrmann, it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Herrmann and Prithviraj to include definitions defines a frame and location of content with which to fill in said frame.

In essence the motivation provided in the Examiner's Action is merely that the references are similar. This is an incorrect application of the law. Controlling authority mandates that the prior art must suggest a desirability of the modification. The mere fact that a reference can be modified does not render the resultant modification obvious. MPEP 2143. The Examiner's Action failed to indicate the desirability of replacing the ActiveDocument of Herrmann's invention with a definition that defines a frame and a location of content with which to fill said

frame. The Applicants submit making such a replacement would not advance the stated goal of Herrmann, which is to provide a formed based environment for partitioning an application such that it can be seamlessly integrated into corporate Webs (intranets). Prithviraj also failed to teach or suggest why replacing the ActiveDocument of Herrmann with a definition would be desirable.

It is impermissible to first ascertain factually what the inventor did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the invention from such prior art.

For the above reasons, the Applicants respectfully submit that the rejections under 35 U.S.C. 103(a) are improper, and accordingly, claims 1-6 and 10 are allowable.

CLAIM REJECTIONS- 35 U.S.C. § 102

In the Office Action, Claims 7-9 and 11 are rejected under 35 U.S.C. § 102(e) as being anticipated by D'Arlach et al. (D'Arlach), US Patent No. 6,026,433. Applicants respectfully disagree for the reasons provided below.

D'Arlach is directed to methods for creating and editing a website using customizable templates. As the Examiner noted (Col. 5, lines 14-25), the templates are stored in a server computer. These templates are stored as database files that create or edit content that can then be published as a website. The templates in the database can be edited to create new templates and forms that are stored as HTML documents on the server (Col. 5, lines 47-50). When a site from a template is published, D'Arlach generates a directory in the server and actually creates and stores the associated files in the directory. (Col. 6, lines 49-54). For example, D'Arlach indicates that two types of HTML files are generated and stored: a graphics-intensive version and a text-only version. (Col. 6, lines 55-60).

In contrast, the invention of claims 7-9 and 11 does not create or store documents on a host or server and further, does not allow a user to similarly create or edit content. Instead, as recited in the method of hosting in claim 7, the invention stores definitions that define a frame and a location of the content that fills the frame. Stated differently, the host server stores a collection of components that are only pointers to data not stored on the host server. While the

templates in D'Arlach are used to create, edit and store content, the invention does not create, edit or store existing content. Instead, the definitions in the present invention are instructions as to how to assemble content and components having control over content but not residing on the host server. At no time does the host server actually edit, assemble, or store content or a document.

Claim 8 is similarly distinguishable over D'Arlach. The method of hosting in claim 8 allows for modifying an empty definition to create and store definitions that define a frame and a location of the content that fills the frame. The differences over D'Arlach provided with respect to claim 7 similarly apply with respect to independent claims 8 and 11 and dependent claim 9.

CONCLUSION

In light of the above, Applicants respectfully submit that the pending claims are allowable. Applicants believe a telephone interview would help clarify issues of the present application and advance prosecution of this case, and respectfully request the Examiner to contact the undersigned attorney to set up a mutually convenient time for a telephone interview.

Respectfully submitted,

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Enclosure